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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,633	02/19/2002	Gerald S. Pullman	07648.0025	2604

7590 11/30/2004  
Finnegan, Henderson, Farabow,  
Garrett & Dunner, L.L.P.  
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Washington, DC 20005-3315

EXAMINER

HAAS, WENDY C

ART UNIT PAPER NUMBER

1661

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/076,633

**Applicant(s)**

PULLMAN ET AL.

**Examiner**

Wendy C Haas

**Art Unit**

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) 1-20,22,23,25-48 and 50-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 24, 49, 95-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 4, 2004 has been entered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 24 and 95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear from Claim 21 whether applicant intends to claim (1) a culture medium comprising a gibberellin inhibitor and a conifer megagametophyte or a culture medium comprising a gibberellin inhibitor and a conifer zygotic embryo or (2) a culture medium comprising a gibberellin inhibitor and a conifer megagametophyte or a culture medium comprising a conifer zygotic embryo. As such, the claim is indefinite because it is unclear. Claims 24 and 95 depend on Claim 21.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21 and 95 are rejected under 35 U.S.C. 102(b) as being anticipated by Acevedo et al.. Acevedo et al. teach a culture medium comprising 20mM  $\beta$ -chlorethyltrimethylammonium (CCC, Cycocel) and embryos and mega-gametophytes of *Araucaria araucana*. CCC is a known gibberellin inhibitor. 20mM of CCC is equivalent to 3.16 ppm [see attached reference from [www.sigmaaldrich.com](http://www.sigmaaldrich.com).] *A. araucana* is a South American conifer in the *Order Coniferales*, *Family Araucariaceae*.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 49, 96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acevedo et al.. The teachings of Acevedo et al. are set forth above.

Claim 24 is obvious in view of Acevedo et al. because paclobutrazol (Bonzi) is also a gibberellin inhibitor known in the art. One would be motivated to substitute paclobutrazol for

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CCC for a variety of reasons such as ready availability, concerns about toxicity, or the GA<sub>3</sub> inhibiting efficacy of paclobutrazol over a greater range of species (which is known in the art). A person of ordinary skill in the art at the time the invention was made would have a reasonable expectation of success substituting a more effective gibberellin inhibitor for a less effective one, absent empirical evidence to the contrary. As such, the invention as a whole was prima facie obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 49 is obvious in view of Acevedo et al. because a previously initiated somatic embryo would develop in cell culture in the same way a mega-gametophyte or zygotic embryo would. As such, any appropriate medium for mega-gametophytes or zygotic embryos would be an obvious choice for somatic embryos as well. As such, the invention as a whole was prima facie obvious to a person of ordinary skill in the art at the time the invention was made.

Claims 96 and 97 are obvious in view of Acevedo et al. for the reasons set forth in the explanations of why Claims 24 and 49 are obvious, and because a person of ordinary skill in the art would be motivated to optimize the concentration of GA<sub>3</sub> inhibitor within any effective set of concentrations known in the art (i.e. such as the 3.16 ppm recited in Acevedo et al.) and could readily do so without undue experimentation. As such, the invention as a whole was prima facie obvious to a person of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

No claim is allowed.

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***References Cited***

The references cited but not applied in any rejection herein are attached to show the state of the art. The Chinese reference may be 102(b) prior art, but the Examiner must wait for a translation to confirm this.

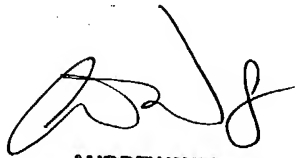
***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

  
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